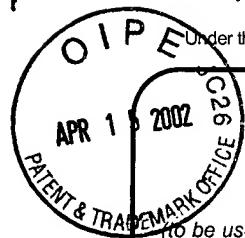


Please type a plus sign (+) inside this box →

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.



TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number	09/153,621
Filing Date	September 15, 1998
First Named Inventor	Roger Q. Smith
Group Art Unit	2841
Examiner Name	T. Dinh
Total Number of Pages in This Submission	Attorney Docket Number
	TN-1444

ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment / Response	<input type="checkbox"/> Licensing-related Papers	<input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s)	
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application		Remarks
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Adan Ayala, Esq.
Signature	
Date	April 5, 2002

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on this date:

Typed or printed name	Adan Ayala, Esq.
Signature	
Date	April 5, 2002

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

Under the Paperwork Reduction Act of 1995, persons are required to respond to a collection of information unless it displays a valid OMB control number.

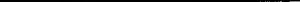
OFFICE TRANSMITTAL
for FY 2002

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT (\$ 320 Attorney Docket No. TN-1444

METHOD OF PAYMENT (check one)				FEE CALCULATION (continued)			
<input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge indicated fees and credit any over payments to:				3. ADDITIONAL FEES			
Deposit Account Number		02-2548		Fee Code	Large Entity Fee (\$)	Small Entity Fee (\$)	Fee Description
Deposit Account Name		Black & Decker Inc.		105	130	205	Surcharge - late filing fee or oath
<input checked="" type="checkbox"/> Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17				127	50	227	Surcharge - late provisional filing fee or cover sheet.
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27				139	130	139	Non-English specification
<input type="checkbox"/> Payment Enclosed:				147	2,520	147	For filing a request for reexamination
<input type="checkbox"/> Check <input type="checkbox"/> Credit card <input type="checkbox"/> Money Order <input type="checkbox"/> Other				112	920*	112	Requesting publication of SIR prior to Examiner action
				113	1,840*	113	Requesting publication of SIR after Examiner action
				115	110	215	Extension for reply within first month
				116	400	216	Extension for reply within second month
				117	920	217	Extension for reply within third month
				118	1,440	218	Extension for reply within fourth month
				128	1,960	228	Extension for reply within fifth month
				119	320	219	Notice of Appeal
				120	320	220	Filing a brief in support of an appeal
				121	280	221	Request for oral hearing
				138	1,510	138	Petition to institute a public use proceeding
				140	110	240	Petition to revive – unavoidable
				141	1,280	241	Petition to revive – unintentional
				142	1,280	242	Utility issue fee (or reissue)
				143	460	243	Design issue fee
				144	620	244	Plant issue fee
				122	130	122	Petitions to the Commissioner
				123	50	123	Processing fee under 37 CFR 1.17 (q)
				126	180	126	Submission of Information Disclosure Stmt
				581	40	581	Recording each patent assignment per property (times number of properties)
				146	740	246	Filing a submission after final rejection (37 CFR § 1.129(a))
				149	740	249	For each additional invention to be examined (37 CFR § 1.129(b))
				179	740	279	Request for Continued Examination (RCE)
				169	900	169	Request for expedited examination of a design application
				Other fee (specify) <u>098 - Processing Fee</u>			
				*Reduced by Basic Filing Fee Paid		SUBTOTAL (3) (\$).320	

******or number previously paid, if greater; For Reissues, see above

SUBMITTED BY					Complete (if applicable)
Name (Print/Type)	Adan Ayala, Esq.	Registration No. Attorney/Agent)	38,373	Telephone	410-716-2368
Signature				Date	April 5, 2002

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO:** Assistant Commissioner for Patents, Washington, DC 20231.



~~UTILITY PATENT~~

B&D No. P-US-TN1444

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Roger Q. SMITH

Serial No.: 09/153,621

Examiner: T. Dinh

Filed: September 15, 1998

Group Art Unit: 284F

For: **HEAVY-DUTY AUDIO EQUIPMENT**

Assistant Commissioner for Patents
Washington, DC 20231

4 www.162200.com

APPEAL BRIEF

I, Adan Ayala, Reg. No. 38,373, certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to the Commissioner of Patents and Trademarks, Washington DC 20231 on

Trademarks, Washington
Apr. 5, 2002

Adan Ayala

#25
TRACEY BELL
4-25-02

TABLE OF CONTENTS

	<u>Page No.</u>
I. INTRODUCTION	1
II. REAL PARTY INTEREST	2
III. RELATED APPEALS AND INTERFERENCES	2
IV. STATUS OF CLAIMS	2
V. STATUS OF AMENDMENTS	2
VI. SUMMARY OF INVENTION	3
VII. ISSUE	4
VIII. GROUPING OF CLAIMS	4
IX. ARGUMENT	4
<u>Claims 1-6 are Patentable under 35 USC § 103(a)</u>	4
<u>Over Brown in view of Pritchard.</u>	4
A. Brown and Pritchard are not Analogous Prior Art.	5
B. The Examiner has not Established a <i>Prima Facie</i> Case of Obviousness that Brown and Pritchard Should be Combined.	8
1. No Motivation to Combine Brown with Pritchard Exists.	9
2. The Brown/Pritchard Combination does not Teach all the Claimed Elements.	14
X. APPENDICES	15
XI. CONCLUSION	16

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: **Roger Q. SMITH**

Serial No.: **09/153,621**

Examiner: **T. Dinh**

Filed: **September 15, 1998**

Group Art Unit: **2841**

For: **HEAVY-DUTY AUDIO EQUIPMENT**

Assistant Commissioner for Patents
Washington, DC 20231

APPEAL BRIEF

I, Adan Ayala, Reg. No. 38,373, certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to the Commissioner of Patents and Trademarks, Washington DC 20231 on

April 15, 2002



Adan Ayala

Dear Sir:

I. INTRODUCTION

A final Office Action was mailed on January 14, 2002. A Request for Reconsideration was filed on January 22, 2002, and a Supplemental Request for Reconsideration was filed on January 24, 2002. The Examiner mailed an Advisory Action on January 28, 2002. In response to such

Advisory Action, a Notice of Appeal was mailed on February 13, 2002, for the above-identified application. The present appeal brief is being timely filed in triplicate, as required under 37 CFR § 1.192.

II. REAL PARTY INTEREST

The real party in interest in the present case is Black & Decker Inc. An assignment transferring all rights to the present application and resulting patents was filed in the present application. The assignment was recorded on November 2, 1998 and can be found at Reel 9560, Frame 0625.

III. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences related to the present case are currently pending.

IV. STATUS OF CLAIMS

Claims 1-6 and 15-20 are currently pending in the present application.

Claims 1-6 are rejected and are presently appealed.

V. STATUS OF AMENDMENTS

Two Request for Reconsideration were filed in response to the Final Office Action. None amended the claims. In the Advisory Action, the Examiner noted that these requests would be not entered for purposes of appeal.

VI. SUMMARY OF INVENTION

Pursuant to 37 CFR § 1.192 and MPEP § 1206, Applicant/appellant hereby provides a concise explanation of the inventions defined in the claims involved in the present appeal. This explanation refer to the specification by page and line number and to the drawings, as required by the CFR and the MPEP rules. However, the following explanation only refers to the embodiments disclosed in the specification and does not discuss alternative mechanisms that would be covered by the claims. Accordingly, the following explanation should not be used to limit the scope of the claims.

Independent Claim 1 calls for an audio equipment 10 comprising a housing 11 and an audio circuitry installed within the housing 11. Spec., p. 2, lns. 16-18. The audio equipment 10 also comprises a first protective bar 20 flexibly connected to the housing 11. Spec., p. 3, lns. 12-13.

Claim 2 is dependent upon Claim 1, and thus includes all the elements of Claim 1 described above. Claim 2 further defines that the audio equipment 10 further comprises a handle 21 attached to the first protective bar 20. Spec., p. 3, lns. 21-22.

Claim 3 is dependent upon Claim 1, and thus includes all the elements of Claim 1 described above. Claim 3 further defines that the audio equipment 10 further comprises a connector assembly 30 flexibly connecting the first protective bar 20 to the housing 11. Spec., p. 4, lns. 3-6.

Claim 4 is dependent upon Claim 3, and thus includes all the elements of Claim 3 described above. Claim 4 further defines that the connector assembly 30 comprises a flexible gasket 31. Spec., p. 4, lns. 6-8.

Claim 5 is dependent upon Claim 4, and thus includes all the elements of Claim 4 described above. Claim 5 further defines that the flexible gasket 31 is disposed between the first protective bar 20 and the housing 11. Spec., p. 4, lns. 8-10.

Claim 6 is dependent upon Claim 1, and thus includes all the elements of Claim 1 described above. Claim 6 further defines that the audio equipment 10 further comprises a second protective bar 20 flexibly connected to the housing 11. Spec., p. 3, lns. 12-13 & 20-21.

VII. ISSUE

Whether Claims 1-6 are unpatentable under 35 USC § 103(a) over US Patent No. 2,058,407 (“Brown”) in view of US Patent No. 5,669,323 (“Pritchard”).

VIII. GROUPING OF CLAIMS

For the § 103(a) rejection, Claims 1-6 stand together.

IX. ARGUMENT

Claims 1-6 are Patentable under 35 USC § 103(a) Over Brown in view of Pritchard.

The Board should reverse the Examiner’s improper final rejection of Claims 1-6 under 35 USC § 103(a) based on Brown and Pritchard. In particular, the Examiner erred in combining

Brown and Pritchard for several reasons. Therefore, the Examiner's rejection was improper and should be reversed.

Claim 1 calls for an audio equipment comprising a housing, an audio circuitry installed within the housing, and a first protective bar flexibly connected to the housing. Claims 2-6 are ultimately dependent upon Claim 1.

Admittedly, Brown discloses a housing containing audio circuitry, and that the housing is connected to a leg assembly 14,15. However, this leg assembly is neither the protective bars called for in Claim 1, nor flexibly connected to the housing. The Examiner relies on Pritchard to provide the flexible connection assembly.

The Examiner cannot combine Brown with Pritchard for two reasons. First, Pritchard is not analogous art. Second, the Examiner has not established a *prima facie* of obviousness because (1) no motivation or suggestion to combine Brown with Pritchard exists, and (2) the Brown/Pritchard device would not have all claimed elements.

A. Brown and Pritchard are not Analogous Prior Art.

The Board should find that the Examiner cannot combine Brown and Pritchard because these references are not analogous prior art, and thus reverse the rejection based on both references. According to the CAFC, “[i]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then reasonably pertinent to the particular problem with which the inventor was concerned.”

In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992) (quoted by MPEP

§ 2141.01(a), at 2100-115 (8th ed., Aug. 2001). Since Pritchard relates to canoes and canoes bailers, Pritchard would not be analogous art because it is not in the radio field, i.e., the field of endeavor of Applicant/appellant. Furthermore, Pritchard is not analogous art because a person of ordinary skill in the radio arts would not look in the canoe bailing field for a solution to a problem in the radio field.

Oetiker provides a good example of what can be considered analogous prior art in the mechanical arts, which include the present invention. In *Oetiker*, the applicant claimed an improvement in a hose clamp which differed from the prior art in the presence of a preassembly "hook" which maintained the preassembly condition of the clamp and disengaged automatically when the clamp was tightened. The Board relied upon a reference which disclosed a hook and eye fastener for use in garments, reasoning that all hooking problems are analogous. The CAFC held the reference was not within the field of applicant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments.

In the present case, the Examiner has provided no evidence that a person of ordinary skill, seeking to solve a problem of protecting a radio, would reasonably be expected or motivated to look for flexible connections in automatic bailers for canoes. When asked during a telephone interview why a person of ordinary skill in the art would look there, the Examiner mentioned that the person of ordinary skill would look for any flexible connections anywhere, including the canoe bailing field. When Applicant/appellant's attorney explained that such analysis was

prohibited by *Oetiker*, the Examiner counter-argued that “common sense knowledge” would lead the person of ordinary skill to look in the canoe bailing field.

In the Amendment filed after the interview, Applicant/appellant requested “that the Examiner provide any evidence so that Applicant can fully prepare his argument in the event of an appeal to the Board is necessary.”¹ In the subsequent final Office Action, the Examiner presented no further evidence, other than a counter-argument that Pritchard discloses a flexible connection between a pump and a power supply, and thus it teaches a flexible connection between two parts. “[H]ence, Pritchard is an analogous art,” wrote the Examiner. In other words, the Examiner is arguing that Pritchard is analogous regardless of its field.

The Examiner’s rationales are plainly prohibited by the CAFC. In *Oetiker*, the CAFC held the reference was not within the field of applicant’s endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. Similarly, the Examiner has provided no evidence that a person of ordinary skill, seeking to solve a problem of protecting a radio, would reasonably be expected or motivated to look for flexible connections in automatic bailers for canoes.

Accordingly, just like the PTO was not allowed to bring in hooks from the garment fastening field into the hose clamp fastening field, the Examiner should not be allowed to bring

¹ This request was repeated in the Request for Reconsideration. The Examiner ignored such request and provided no further evidence or arguments in the Advisory Action.

in flexible connections from the canoe bailing field into the radio field, because the Examiner has not provided any evidence that a person of ordinary skill would look in the canoe bailing field.

Applicant/appellant urges the Board to find that Pritchard, a canoe bailer reference, is not analogous to the radio field, and thus that the Examiner erred in combining Brown with Pritchard. Therefore, the Examiner's improper final rejection of Claims 1-6 should be reversed, and the application should be allowed.

B. The Examiner has not Established a *Prima Facie* Case of Obviousness that Brown and Pritchard Should be Combined.

Even if the Board finds that Pritchard is analogous art, the Board should find that Examiner has failed to establish a *prima facie* case of obviousness that Pritchard should be combined with Brown. As set out by the CAFC in *In re Fine*,

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. See *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 U.S.P.Q. 785, 787-88 (Fed. Cir. 1984). It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge general available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *In re Lalu*, 747 F.2d 703, 705, 223 U.S.P.Q. 1257, 1258 (Fed. Cir. 1984); see also *Ashland Oil Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297 n.24, 227 U.S.P.Q. 657, 667 n.24 (Fed. Cir. 1985); *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). This it [sic] has not been done. The board points to nothing in the cited references, either alone or in combination, suggesting or teaching Fine's invention.

In re Fine, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598-99 (Fed. Cir. 1988).

According to MPEP § 2142, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP § 2142, at 2100-121. Second, the prior art references must teach or suggest all the claim limitations. *Id.* In the present case, the Examiner has failed to establish both requirements.

1. No Motivation to Combine Brown with Pritchard Exists.

In the present case, no suggestion to combine or modify Brown with Pritchard exists for three reasons: (a) such modification would render Brown unsatisfactory for its intended purpose; (b) such modification would change the principle of operation of Brown; and (c) the Examiner has not pointed to any suggestion in either Brown or Pritchard to support the combination proposed by the Examiner.

As to the first reason, the CAFC has held that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (*cited by* MPEP § 2143.01, at 2100-124).

In the Office Action, the Examiner proposed to add Pritchard's flexible connection assembly 28 to the Brown device. When asked to clarify such combination during the telephone interview, the Examiner noted that the flexible connection assembly 28 would replace Brown's pivotable connection 16. Such modification would render Brown, the prior art invention being

modified, unsatisfactory for its intended purpose, i.e., maintaining the radio cabinet in a desired tilted position. (See Brown, col. 2, lns. 38-51.)

According to Brown, a pivotal connection is provided between the leg members and the cabinet. This pivotal connection includes block 16 connecting the leg members 14,15 and a circular disk 19 provided on the cabinet, which “is positioned in the recess of the respective block 16.” Brown, col. 2, lns. 26-30 and 38-41. The disk 19 is in frictional contact with the block 16 so that the cabinet can “remain in any of its usual tilted positions.” Brown, col. 2, lns. 43-51. In other words, if the user tilts the radio cabinet to a desired position, the pivotal connection will maintain the cabinet at the desired pivotal position.

According to Pritchard, the flexible connection assembly 28 includes a flexible sleeve 100, which is “made of rubber tubing or of a similar resilient material.” Pritchard, col. 5, lns. 42-44. According to the Merriam-Webster’s Collegiate Dictionary (online edition; see print-outs attached as Appendix B), “resilient” is defined as “characterized or marked by resilience.” “Resilience” in turn is defined as “the capability of a strained body to recover its size and shape after deformation.” Accordingly, a resilient material, such as rubber tubing, would be a material capable of recovering its size and shape after deformation.

If Pritchard’s flexible connection assembly 28 replaces Brown’s pivotal connection, the combined device will have a resilient connection. In other words, if the user tilts the radio cabinet to a desired position, the resilient connection will not maintain the cabinet at the desired pivotal position. Instead, the radio cabinet would return to the untilted position. Accordingly, Brown, the prior art invention being modified, would be rendered unsatisfactory for its intended

purpose, i.e., maintaining the radio cabinet in its tilted position. Thus, no suggestion to modify or combine Brown with Pritchard can exist.

As to the second reason, no suggestion to combine or modify Brown with Pritchard exists because the modification would change the principle of operation of Brown. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349, 352 (CCPA 1959) (*cited by* MPEP § 2143.01, at 2100-125).

As explained above, Brown discloses a pivotal connection relying on friction to maintain the radio cabinet in the desired tilted position. The Examiner proposed replacing such pivotal connection with Pritchard's resilient connection, which would not maintain the radio cabinet in the desired tilted position. This in effect is changing the principle of operation of Brown, the prior art invention being modified. Thus, "the teachings of the references are not sufficient to render the claims *prima facie* obvious" under *Ratti* and MPEP § 2143.01. Therefore, the Brown/Pritchard rejection should be reversed.

In the Final Office Action, the Examiner counter-argued that:

applicant recites a connector assembly 30 in page 4 of the specification (disclosed in figure 4), which is flexible [sic] connecting to a protective bar and a housing, and also in applicant's previous amendment filed on October 01, 2001 emphasized mention [sic] in page 2 that "As mentioned above .. when radio 10 is dropped." Applicant being claimed [sic] a protective bar (but not flexible_) connected to a housing by a flexible connection, which is a flexible connector assembly 30. In combine [sic] of argument (1), Brown in view of Pritchard disclose a leg 14 capable of being a protective bar connected to a housing (1,2) by a flexible connector assembly (28) of Pritchard.

This counter-argument however does not address the Applicant's arguments. The Examiner has not discussed (1) why MPEP § 2143.01 and the legal precedent for the *prima facie* requirement are inapplicable, (2) how combining Brown with Pritchard would not render Brown unsatisfactory for its intended purpose, i.e., maintaining the radio cabinet in a desired tilted position, or (3) how combining Brown and Pritchard does not the principle of operation of Brown. Instead, it appears that the Examiner's counter-argument is that a suggestion to combine Brown and Pritchard exists because they are capable of being combined. This violates MPEP § 2143.01 that reads: "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP §2143.01, at 2100-124 (*citing In re Mills*, 916 F.2d 680 (Fed. Cir. 1990)).

Finally, the Examiner has failed to establish a *prima facie* case of obviousness as the Examiner failed to point out any hint or suggestion in Brown or Pritchard to support the Examiner's proposed combination. In *In re Lee*, the CAFC reversed the Board because both the Examiner and the Board failed to provide "any specific hint or suggestion in a particular reference" to support the combination by the Examiner. *Lee*, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the CAFC noted that doing so constituted "both legal error and arbitrary agency action." *Id.*

The facts of *Lee* are very similar to the present case. During prosecution, Lee "had pressed the examiner ... for some teaching, suggestion, or motivation in the prior art to select and combine the references that were relied on to show obviousness." *Id.* at 1432. In response, the Examiner noted that the combination would have been obvious to one of ordinary skill in the art

because of the advantages gained. *Id.* The Examiner, however, failed to show a specific cite or teaching in the cited references for combining the two references. *Id.* The CAFC found that “the examiner [did not] adequately [support] the selection and combination” of the two cited references and that the Examiner’s conclusory statements did “not adequately address the issue of motivation to combine.” *Id.* at 1434.

Similarly, in the present case, Applicant/appellant has cited to legal precedent and specific portions of the MPEP showing that no motivation to combine exists. The Examiner has arbitrarily ignored such provisions.

Furthermore, Applicant/appellant has requested the Examiner to provide a specific cite in Brown or Pritchard that the two references should be combined. The Examiner noted that:

applicant recites a connector assembly 30 in page 4 of the specification (disclosed in figure 4), which is flexible [sic] connecting to a protective bar and a housing, and also in applicant’s previous amendment filed on October 01, 2001 emphasized mention [sic] in page 2 that “As mentioned above .. when radio 10 is dropped.” Applicant being claimed [sic] a protective bar (but not flexible) connected to a housing by a flexible connection, which is a flexible connector assembly 30. In combine [sic] of argument (1), Brown in view of Pritchard disclose a leg 14 capable of being a protective bar connected to a housing (1,2) by a flexible connector assembly (28) of Pritchard.

Nowhere in the Examiner’s response is a specific cite in Brown suggesting that Brown’s pivotal connection be replaced with a flexible connection. In the Supplemental Request for Reconsideration, Applicant/appellant explicitly requested “that such cite be provided, so that the Examiner can at least comply with *In re Lee*.” The Examiner nevertheless failed to do so. Therefore, the Board should find that the Examiner has failed to establish that Brown and

Pritchard should be combined under the *prima facie* requirement, and reverse the rejection of Claims 1-6.

2. The Brown/Pritchard Combination does not Teach all the Claimed Elements.

Even if Brown and Pritchard are combined, the combination does not teach all the claimed elements. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974) (*cited by* MPEP § 2143.03). “*All* words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970). (*quoting by* MPEP § 2143.03) (emphasis added). In the present case, the Examiner has failed to show that the leg assembly is “protective.”

As discussed in the specification, the protective bar is provided to protect the housing from being destroyed at a jobsite because of: (1) tools being dropped on the housing; or (2) the radio falling down. In Brown, however, the leg assembly does not serve to protect the radio. For example, Applicant notes that FIG. 5 of Brown shows no protection for the housing surrounding speaker 6a against any side blows.

Accordingly, the leg assembly only serves to support the radio in place. Therefore, the leg assembly is not a “protective” bar as called for in Claim 1. Pritchard does not supplement such missing element either. Thus, the Brown/Pritchard combination cannot render Claim 1 and its dependent claims unpatentable.

The Examiner's response to such argument was: "Regarding to argument (3), [sic] combination of (1) and (2), [sic] Brown in view of Pritchard would teach all of the limitation of claimed invention." This counter-argument does not address how the leg assembly is a protective bar. In the Request for Reconsideration, Applicant/appellant explicitly requested that "the Examiner show how Brown's leg assembly is protective so that Applicant can address the Examiner's counter-arguments in an appeal to the Board." The Examiner failed to do so.

Accordingly, because the Brown/Pritchard combination lacks all the elements of Claims 1-6, the Examiner has not met his burden in establishing a prima facie obviousness case. Therefore, the Board should hold that the present rejection based on Brown and Pritchard is improper and should be reversed.

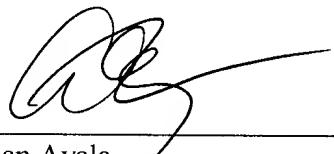
X. APPENDICES

Applicant/appellant has attached two appendices. In particular, Appendix A contains a copy of the claims involved in the appeal. In addition, Appendix B are print-outs of the Merriam-Webster's Collegiate Dictionary (online edition) definitions for "resilient" and "resilience."

XI. CONCLUSION

Based on the foregoing, Applicant/appellant urges the Board to rule that Claims 1-6 are patentable under 35 USC § 103(a) over Brown in view of Pritchard.

Respectfully submitted,



Adan Ayala
PTO Reg. No. 38,373
Attorney for Applicant/appellant

Appendices attached

APPENDIX A

1. An audio equipment comprising:
 - a housing;
 - an audio circuitry installed within the housing; and
 - a first protective bar flexibly connected to the housing.
2. The equipment of Claim 1, further comprising a handle attached to the first protective bar.
3. The equipment of Claim 1, further comprising a connector assembly flexibly connecting the first protective bar to the housing.
4. The equipment of Claim 3, wherein the connector assembly comprises a flexible gasket.
5. The equipment of Claim 4, wherein the flexible gasket is disposed between the first protective bar and the housing.
6. The equipment of Claim 1, further comprising a second protective bar flexibly connected to the housing.



un·abridged \,ən-ə-ˈbrijd\
adj : being the most complete
in its class

The dictionary
is just the
beginning.

Pa
Introduc
to Word

Merriam-Webster's COLLEGIATE® DICTIONARY

Merriam-
Webster

The dict
be
Find ou
Merri
Un

[Collegiate® Dictionary](#) [Collegiate® Thesaurus](#) [Unabridged](#)

One entry found for **resilient**.

Main Entry: **re·sil·ient**

Pronunciation: -y&nt

Function: *adjective*

Etymology: Latin *resilient-*, *resiliens*, present participle of *resilire* to jump back, recoil, from *re-* + *salire* to leap -- more at [SALLY](#)

Date: 1674

: characterized or marked by resilience : as a : capable of withstanding shock without permanent deformation or rupture b : tending to recover from or adjust easily to misfortune or change

synonym see [ELASTIC](#)

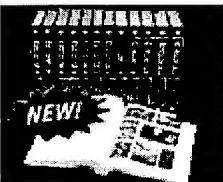
- **re·sil·ient·ly** *adverb*

Dic

The

britor

Shopping



Encyclopædia
Britannica 2002 Print
Set Suite
Price: USD \$1295
Available via
installment plan at 0%
interest!



Encyclopædia
Britannica 2002 Deluxe
Edition CD-ROM (WIN)
Price: USD \$44.95 After
Rebate



Get the [Top 10 Most Popular Sites for "resilient"](#)

Get the [Word of the Day](#) e-mailed every morning. It's free! Click here.

► [Search the Unabridged Dictionary on-line](#)
and enjoy enhanced versions of Merriam-Webster's Collegiate® Dictionary and Thesaurus at Merriam-Webster Unabridged.

► [Listen to Word for the Wise radio programs](#)
Listen to broadcasts or read transcripts of previous Word for the Wise programs on public radio.

4
ASK JE
resili

Merris
dictionar

Pronunciation Symbols

\&\ as a and u in *about*
\&\ as e in *kitten*
\&\ as ur/er in *further*
\a\ as a in *ash*
\A\ as a in *ace*
\ä\ as o in *mop*
\au\ as ou in *out*
\ch\ as ch in *chin*

\e\ as e in *bet*
\E\ as ea in *easy*
\g\ as g in *go*
\i\ as i in *hit*
\I\ as i in *ice*
\j\ as j in *job*
\[ng]\ as ng in *sing*
\O\ as o in *go*

\o\ as aw in *law*
\oi\ as oy in *boy*
\th\ as th in *thin*
\[th]\ as th in *the*
\ü\ as oo in *loot*
\u\ as oo in *foot*
\y\ as y in *yet*
\zh\ as si in *vision*

For more information see the [Guide To Pronunciation](#).

Save 20% on the 2001
Year in Review!
Price: USD \$19.95

[Home](#)

[Link to Us](#)

[Advertising Info](#)

[Company Info](#)

[Contact Us](#)

[Visit Britannica Store](#)

© 2002 by Merriam-Webster, Incorporated
[Merriam-Webster Privacy Policy](#)





un·abridged \,ən-ə-'brijd\
adj : being the most complete
 in its class

The dictionary
 is just the
 beginning.

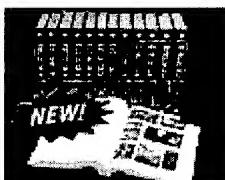
 Pa
 Introdu
 to Word

Merriam-Webster's COLLEGIATE® DICTIONARY



- ▶ [Home](#)
- ▶ [Help](#)
- ▶ [Word of the Day](#)
- ▶ [Word Games](#)
- ▶ [Word for the Wise](#)
- ▶ [Books and CDs](#)
- ▶ [Company Info](#)
- ▶ [Customer Service](#)
- ▶ [Network Options](#)
- ▶ [Language Zone](#)
- ▶ [The Lighter Side](#)
- ▶ [Site Map](#)

Shopping



Encyclopædia
Britannica 2002 Print
Set Suite
Price: USD \$1295
Available via
installment plan at 0%
interest!



Encyclopædia
Britannica 2002 Deluxe
Edition CD-ROM (WIN)
Price: USD \$44.95 After
Rebate



[Collegiate® Dictionary](#) [Collegiate® Thesaurus](#) [Unabridged](#)

One entry found for **resilience**.

Main Entry: **re·sil·ience**

Pronunciation: *ri-’zil-y&n(t)s*

Function: *noun*

Date: 1824

1 : the capability of a strained body to recover its size and shape after deformation caused especially by compressive stress
 2 : an ability to recover from or adjust easily to misfortune or change

Get the [Top 10 Most Popular Sites for "resilience"](#)

Get the [Word of the Day](#) e-mailed every morning. It's free! Click here.

- ▶ [Search the Unabridged Dictionary on-line](#)
 and enjoy enhanced versions of Merriam-Webster's Collegiate® Dictionary and Thesaurus at Merriam-Webster Unabridged.
- ▶ [Listen to Word for the Wise radio programs](#)
 Listen to broadcasts or read transcripts of previous Word for the Wise programs on public radio.

Pronunciation Symbols

\&\ as a and u in <i>about</i>	\e\ as e in <i>bet</i>	\o\ as aw in <i>law</i>
\&\ as e in <i>kitten</i>	\E\ as ea in <i>easy</i>	\oi\ as oy in <i>boy</i>
\&\ as ur/er in <i>further</i>	\g\ as g in <i>go</i>	\th\ as th in <i>thin</i>
\a\ as a in <i>ash</i>	\i\ as i in <i>hit</i>	\[th]\ as th in <i>the</i>
\A\ as a in <i>ace</i>	\I\ as i in <i>ice</i>	\u\ as oo in <i>boot</i>
\ä\ as o in <i>mop</i>	\y\ as j in <i>job</i>	\u\ as oo in <i>foot</i>
\au\ as ou in <i>out</i>	\[ng]\ as ng in <i>sing</i>	\y\ as y in <i>yet</i>
\ch\ as ch in <i>chin</i>	\O\ as o in <i>go</i>	\zh\ as si in <i>vision</i>

For more information see the [Guide To Pronunciation](#).

[Home](#)

[Link to Us](#)

[Advertising Info](#)

[Company Info](#)

[Contact Us](#)

Save 20% on the 2001

Year in Review!

Price: USD \$19.95

Visit Britannica Store

© 2002 by Merriam-Webster, Incorporated

[Merriam-Webster Privacy Policy](#)